



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
Washington, D.C. 20231
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/800,535	03/06/2001	Gavin A. Grounds	70-00-005	4164

7590

11/07/2002

William R. Borchers
Baker Botts L.L.P.
Suite 600
2001 Ross Avenue
Dallas, TX 75201-2980

EXAMINER

GARG, YOGESH C

ART UNIT

PAPER NUMBER

3625

DATE MAILED: 11/07/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/800,535

Applicant(s)

GROUNDS, GAVIN A.

Examiner

Yogesh C Garg

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-54 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-54 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

2. Claims 1-2, 4-18, 48, 50-54 are rejected under 35 U.S.C. 102(b) as being anticipated by Weber.

With regards to claims 1-2, 4-18, 48, 50-54, Weber teaches an apparatus for processing financial transactions comprising the following structural limitations:

a memory which is a Random Access Memory, a processor coupled to the memory, a communication interface adapted to be coupled to a communication link and coupled to the memory (at least see, col.4, lines 29-44, "*According to a preferred embodiment of the invention, a server communicates bi-directionally with a server over a first communication link, over which service requests flow to the server for one or more merchants and/or consumers..... Service requests result in merchant specific transactions that are transmitted to the gateway for further processing on existing host applications.....*", col. 6, line 44-col.7,

Art Unit: 3625

line 2, "...A preferred embodiment of a system in accordance with the present invention is preferably practiced in the context of a personal computer A representative hardware environment is depicted in FIG. 1A, which illustrates a typical hardware configuration of a workstation in accordance with a preferred embodiment having a central processing unit 10, such as a microprocessor, includes a Random Access Memory (RAM) 14, Read Only Memory (ROM) 16,..., a user interface adapter 22 for connecting a keyboard 24, a mouse 26,, and/or other user interface devices such as a touch screen (not shown) to the bus 12, communication adapter 34 for connecting the workstation to a communication network (e.g., a data processing network).. Those skilled in the art will appreciate that the present invention may also be implemented on platforms and operating systems other than those mentioned").

The rest of the language of the claims 1-2, 4-18, 48, 50-54 is directed to the intended/functional use rather than the limitation of structural elements. Please refer to MPEP: 2114: Apparatus and Article Claims - Functional Language APPARATUS CLAIMS MUST BE STRUCTURALLY DISTINGUISHABLE FROM THE PRIOR ART: Claims directed to apparatus must be distinguished from the prior art in terms of structure rather than function. In re Danly, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device is, not what a device does." Hewlett- Packard Co. v. Bausch & Lomb Inc., 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990). (emphasis in original). Therefore, as per the guidelines of MPEP 2114, the claims 1-2, 4-18, 48, 50-54 do not distinguish over Weber which discloses the structural limitations of the claims i.e. a memory which is a Random Access Memory, a processor coupled to the memory, a communication interface adapted to be coupled to a communication link and coupled to the memory.

Art Unit: 3625

3. Claims rejected 19-47 under 35 U.S.C. 102(e) as being anticipated by Elgamal (US Patent 6,138,107).

With regards to claims 19-32, Elgamal teaches a method for processing financial transactions, comprising: receiving a first message indicating the making of a financial transaction, the first message including customer information, merchant information and transaction information, customer and merchant information comprise a digital certificate, transaction information comprising the time of initiation of the transaction, the amount and the customer identifier which represents a credit card account, determining the validity of the customer information and merchant information, determining the validity of the customer information comprising generating a validation request, receiving a validation response and analyzing the validation response, generating a second message indicating non-authorization of the financial transaction if the customer information or merchant information is invalid, determining whether the financial transaction involves a micro-payment i.e. the amount of transaction is below a threshold if the customer and merchant information is valid, if the financial transaction involves a micro-payment: storing at least part of the transaction information, associated with the merchant, comprising the initiation time, amount of the transaction and the customer account identifier, generating a third message indicating authorization of the financial transaction, and if the financial transaction does not involve a micro-payment, generating an authorization request, generating a fourth message at a designated time to settle the financial transaction based on the stored information, and generating a fifth message to settle all of the financial transactions based on the part information stored for each financial transaction in the buffer (col.5, line 38-col.12, line 61, "... *The system should be able to handle such transactions as small payments from customers.....such that said merchant and said acquirer ate authenticated to each other and to said customer.....The PG protocol uses certain buying and*

Art Unit: 3625

selling transactions which are supported by the PG.....In one embodiment.....a customer shops...an item worth \$0.50.....the merchant recognizes that the use of PG is specified....PG then sends an authorization to the merchant....At the end of the predetermined time...the PG uses the SCS as a customer and buys...merchant is paid by a credit card....Validation of the Customer's account.....The Payment gateway 50 includes a database 52 containing information on each merchant and each customer.....The merchant application also verifies an acquirer signature on responses and a customer signature on receipts.....The PG consists of the following components.....Customer database.....Customer name....Customer PG account number....Customer bank account number (s): this is the number of a bank account, credit card...PG may also keep a database of all transactions.....By issuing the slip [Note: slip corresponds to digital certificate], the customer indicates agreement to the transaction. By using the slip for payment the merchant also agrees to the contents of the transaction.....PG requires that the merchant...provides a unique identifier....purchase order contains the following fields: Customer name...total amount...current Date: the time that the slip was created [Note: it corresponds to the initiation time of the financial transaction]....The interface to the acquirer gateway....PG interfaces to the merchants in two ways, the first as a gateway that authorizes micro payments.....The merchant then asks the PG to authorize the payment passing on the encoded payment information.....At the end of a pre specified period of time....PG pays the merchant for the aggregate amount from all transactions completed....PG prepares a purchase order and a payment slip.....An important aspect of the invention is to provide the merchant with the ability to collect several payments into a single transaction with the acquirer.....").

With regards to a set of logic encoded in media claims 33-46, their limitations correspond to method claims 19-32, and are therefore analyzed and rejected similarly.

With regards to claim 47, Random access memory is inherent in the computerized system disclosed by Elgamal.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 3 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weber and further in view of Anderson et al., (US Patent 5,878,423).

With regards to claims 3 and 49, Weber teaches an apparatus for processing financial transactions as disclosed in claims 1 and 48 and analyzed above. Weber does not disclose that the communication interface is a network interface card. As per knowledge generally available, it is a very well known practice to use network interface cards to communicate with remote computers. Anderson teaches that the communication interface is a network interface card (at least see, col.12, lines 23-33, "... *The detailed description symbolic representations of operations by conventional computer components, including a processor, memory storage devices, data communication networks, and communications interfaces such as network interface cardsoperations may utilize conventional computer components in a heterogeneous distributed computing environment, including remote file servers and remote memory storage devices*"). In view of Anderson, it would have been obvious to a person of an ordinary skill in the art at the time of the invention to modify Weber to disclose that the communication interface is a network interface card. Doing

Art Unit: 3625

so would enable users to communicate with remote computers, as suggested in Anderson, "..... another embodiment of the present invention provides a more detailed computer system including a processor, a memory storage device coupled to the processor and a communications interface coupled to the processor for communicating with a remote device, typically a a remote computer").

Conclusion

6. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

(i) US PG-PUB 2002/0103752 A1 to Berger et al., US PG-PUB 2002/0007345 A1 to Harris, US PG-PUB 2002/0152179 A1 to Racov, US PG-PUB 2002/0013765 A1 to Shwartz, US patent 6,070,798 to Nethery, and US patent 6,098,053 to Slater disclose a method, system and a set of logic encoded in a media for processing financial transactions.

(ii) Dahlstorm, Erik, " Understanding the need for micro payments in the digital image", Banking Policy Report; New York: Aug 1999, Vol:18, Issue: 15/16, extracted from <http://proquest.umi.com> on 10/24/2002 discloses the importance of micro payments in financial transactions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yogesh C Garg whose telephone number is 703-306-0252. The examiner can normally be reached on M-F (8:30-4:00).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn W Coggins can be reached on 703-308-1344. The fax phone numbers for the

Art Unit: 3625

organization where this application or proceeding is assigned are 703-305-7687 for regular communications and 703-305-7687 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1113.

Yogesh C Garg
Examiner
Art Unit 3625

YCG
November 4, 2002


JEFFREY A. SMITH
PRIMARY EXAMINER